

- C 2
(cont)
- 1 66. (Newly added) Apparatus as claimed in claim 65 further
 - 2 comprising a second stent, attached to said one leg disposed entirely within
 - 3 said vessel, configured to extend into one of the two branched vessels.

REMARKS

The present invention is directed to a bifurcated prosthesis and method for reinforcing a bifurcated blood vessel.

Claims 1 and 54-61 were pending in this application as of the issuance of the Office Action. By this amendment, Applicants have cancelled claims 1, 55-58, and 60-61, and added claims 62-66. Thus, the claims pending after this amendment are claims 54, 59, and 62-66.

Claim 54 covers a method for delivering a bifurcated endoluminal stent or prosthesis and is indicated in the Office Action to be allowable over the art of record. Applicants thank the Examiner for this indication of allowability. Newly added claim 62 depends from claim 54, and should thus also be allowable. Newly added claim 63 is independent but is also directed to a method for delivering a stent or prosthesis to an angiological bifurcation. Applicants have added claim 63 (and claim 64 which depends on it) to fully cover their invention by claiming it from a different perspective. The added method claims are also allowable over the art of record, and notification to that effect is respectfully requested.

Claim 54 is provisionally rejected, however, under 35 U.S.C. § 101 for double patenting over certain cited applications, and under the doctrine of obviousness-type double patenting over co-pending application Serial No. 08/317,763.

As to the provisional 35 U.S.C. § 101 rejection of claim 54, Applicants have canceled (or will cancel) the claims corresponding to claim

54 in the cited applications, and none of those applications include claims corresponding to the claims added by this amendment. Such cancellations obviate the statutory double patenting rejection. (Applicants included identical claims in this and the cited applications--which are related divisional applications--because the U.S. parents of the applications received restriction requirements as between each of the claims presented in this and the related applications. Applicants therefore filed the divisional applications from those parent applications shortly before the effective date of GATT changes to ensure maximum protection for Applicants' invention.)

As to the obviousness-type double patenting rejection of claim 54, Applicants will file a terminal disclaimer in this application upon maturity of the provisional rejection into a full rejection upon issuance of a patent on the '763 application.

Claim 59 covers a bifurcated prosthesis and stands rejected in the Office Action under 35 U.S.C. § 101 for double patenting over the same cited applications as in the rejection of claim 54. Claim 59 is also rejected under § 102(e) as anticipated by Barone or Chuter and under § 102(b) as anticipated by Ersek or MacGregor.

As to the double-patenting rejection, claims corresponding to claim 59 have been or will be cancelled in the cited applications. This obviates the double-patenting rejection. (As to why the same claims were filed in these applications, see the explanation given above.)

As to the 35 U.S.C. § 102(e) rejections, Barone teaches a bifurcated graft with stents at the ends thereof for securing the graft in place (see Fig. 7, for example). Barone does not teach, however, a bifurcated prosthesis having a "bifurcated proximal stent portion" as defined in claim 59. Only the graft portion of Barone is bifurcated, not the supporting stent members. The bifurcated stent defined in claim 59 provides Applicant's

claimed apparatus with support not achievable only by anchoring the ends of the graft. Barone thus cannot anticipate, or render obvious, claim 59.

Similarly, Chuter teaches a bifurcated graft anchored at its ends by stents as shown, for example, in Fig. 47. For the same reasons given above, this reference cannot anticipate or render obvious claim 59.

As to the 102(b) rejections, Ersek also teaches only a bifurcated graft with stents at the ends for anchoring the graft to the vessel walls. As with the previous two references, there is no disclosure in Ersek of a bifurcated stent as defined in claim 59. For the reasons given above, Ersek cannot anticipate or render obvious claim 59.

MacGregor teaches a bifurcated stent as shown in Fig. 1. There is no teaching in MacGregor, however, of a "graft layer formed from a biocompatible fabric disposed in juxtaposition with said bifurcated stent" as defined in claim 59. Because there is no suggestion in MacGregor, or in the art generally, of using a graft layer over a bifurcated stent, it cannot be said that MacGregor anticipates or renders obvious the particular combination defined in claim 59.

Newly added claim 65 defines apparatus for placement at an aneological bifurcation comprising "a first bifurcated graft member, at least partially supported by a stent member, having two legs, at least one of which is configured to be disposed entirely within said vessel." There is no teaching in the art of such a bifurcated graft member having at least one leg disposed entirely in the vessel such that it does not extend into one of the branched vessels. Claim 65 (and newly added claim 66 which depends from it and further defines a second stent attached to the bifurcated stent and configured to extend into one of the branched vessels) are thus allowable over the art.

Accordingly, in light of the foregoing amendments and remarks, it is respectfully submitted that all claims of the present application are in condition for allowance, which action is respectfully requested.

Respectfully Submitted,



Paul F. Prestia, Reg. No. 23,031

Allan M. Wheatcraft, Reg. No. 36,307

Attorneys for Applicant

AMW/mjc

Dated: December 16, 1996

Suite 301

One Westlakes, Berwyn

P.O. Box 980

Valley Forge, PA 19482-0980

(610) 407-0700

The Assistant Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on:

December 16, 1996 ✓
